

Serial No. 10/577,135

Attorney Docket No. VX062735PCT

REMARKS

Claims 1-17 are pending in the application. Reconsideration of the present application is respectfully requested.

The claims have been amended to better describe the invention. Support for amendments to original Claims 1-5, 7, 9 and 11 can be found throughout the specification, for example on page 3, lines 10-27 and page 8, second paragraph. New claims 12-17 are supported throughout the specification, for example on page 3, lines 17-29; page 5, lines 12-25; page 7, lines 4-6, page 8, first paragraph; and page 9, lines 19-23.

The specification has been amended to correct minor noted informalities. No new matter has been introduced by way of these amendments. Specifically the specification now states that this case is a 371 of PCT/JP2004/015470 filed on October 20, 2006.

Claims 1-11 have been rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 2002-053468 (JP '468) or European Patent No. 1208755 (EP '755). The Examiner has argued that the claimed medicinal, food and cosmetic composition read on nothing more than an old compound in a conventional carrier such as water.

Claims 1-11 have been rejected under 35 U.S.C. 102(a) as being anticipated by Smirnov et al. (Smirnov). The Examiner has argued that Smirnov discloses food, cosmetic and pharmaceutical compositions comprising anthocyan.

The referenced JP '468 teaches a cancer or therapeutic agent containing cyanidin compound as an active ingredient. The referenced EP '755 teaches a method of extracting relatively high amounts of black currant anthocyanin by use of a charged reverse osmosis membrane. The resulting anthocyanin can be used in foods, which results in measurable improvements in visual function, improving blood fluidity and lowering blood pressure.

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The Smirnov patent discloses an anthocyanic colorant composition and a process for production of an anthocyanic colorant composition. The purpose of the compositions of Smirnov is to add color to food, cosmetic and pharmaceutical compositions.

To the extent that the above mentioned art rejections apply to the newly amended claims, Applicant's respectfully disagree for the following reasons.

The Examiner has concluded that the present invention is encompassed by the art because the claims read on an old compound in a conventional carrier such as water. The Examiner has failed to consider the tyrosinase inhibitory activity of the present invention and the process claimed therein. JP '468, EP '755 and the Smirnov patent are all silent as to the discovery of any tyrosinase inhibitory activity of cyanidin compounds and the process as claimed in the present application.

Applicants' respectfully argue that the claimed invention recites the discovery of a new use/process for an old structure based on unknown properties of the structure and the process of use recited in the applicants' claimed invention. MPEP §2112.02 citing *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 163 (CCPA 1957). Furthermore, pertinent sections of MPEP §2111.02 state that the claim preamble must be read in the context of the entire claim to give life, meaning and vitality to the claim. For example, in *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003), the Court considered the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," and the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose. Similarly, the tyrosinase inhibiting activity composition of Claim 1 is directed to a newly discovered method for the

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treatment of an ameliorant for facial blood flow and improving spots, freckles, dark undereye circles and dullness on the skin.

The presently claimed invention discloses a composition "comprising an effective amount of anthocyan for inhibiting tyrosinase activity," whereby further dependent claims recite the unexpected effects, *inter alia*, of the composition and application to skin thereof to be used as an ameliorant for the improvement of facial blood flow, and for reducing spots, freckles, dark undereye circles and dullness of on the skin. JP '468, EP '755 and the Smirnov patent do not disclose an effective amount of anthocyan for inhibiting tyrosinase activity because the references are silent as to this effect at all and the process of using the composition on skin to produce new properties. Therefore, given the teachings of JP '468, EP '755 and the Smirnov patent, the ordinary artisan cannot possibly determine what an effective amount of anthocyan for inhibiting tyrosinase activity would be and the use on the skin and therefore cannot possibly obtain the present invention as claimed.

The present invention is distinguishable from JP '468, EP '755 and the Smirnov patent referenced in the Office Action in that none of the references teaches applicant's claimed invention of a tyrosinase inhibitory activity composition comprising an effective amount of anthocyan and the process for the use thereof that reduces spots and freckles and is an ameliorant for facial blood flow. Conventional melanin-production inhibitors do not include a composition with an effective amount of anthocyan and the process for the use thereof that is superior at inhibiting tyrosinase activity and thereby melanin activity, which ameliorates facial blood flow, and reduces skin spots and freckles.

Smirnov discloses a colorant, particularly useful for the coloring of food. There is no language in Smirnov reciting a composition with an effective amount of anthocyan for

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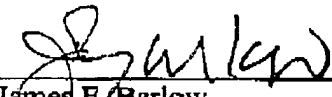
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inhibiting tyrosinase activity and the process to use on skin that recites an ameliorant for improving facial blood flow and reduces color in the skin appearing as spots, freckles.

As JP '468, EP '755 and the Smirnov patent each clearly fail to teach or disclose all features of the present claims, the Examiner has failed to establish a *prima facie* case of anticipation. In view of the foregoing, applicants respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,


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